

Application No. 09/682,489

REMARKS

The FINAL Office Action of July 8, 2004 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested. Claims 1-3, 5-8, 10-11, 13-14, 19, 22, and 25-35 are pending in this application. Of these, claims 1, 25, and 30 are independent claims. An amendment faxed April 19, 2004 amended claims 1-2, 5-6, 9, 19, and 22, canceled claims 4, 9, 12, 15-18, 20-21, and 23-24, and added new claims 25-35.

This amendment amends the claims to correct a typographical error in independent claims 1, 25, and 30 that specifies an action is performed by the output device instead of the document server. Support for this amendment is shown in Figure 3 at 316, which is described at paragraph 0068 in Applicant's specification. Applicant respectfully requests entry of these amendments to the claims as they place the application in better condition for allowance or appeal.

1. Response to Rejection Under 35 USC 103

The Office Action starting on page 2 rejects claims 1-3, 5-8, 10, and 11 under 35 USC 103(a) as being unpatentable over Carter et al., U.S. Patent No. 6,201,611 (hereinafter referred to as "Carter") in view of Narayanaswamy, U.S. Patent No. 6,611,358 (hereinafter referred to as "Nara").

Carter discloses a print rendering server system coupled to a network, which in response to a print request from a resource limited client system, "a print job in a print ready format is produced and sent back for local printing by the resource limited client system" (see Abstract). Upon receiving a print request that includes (in part only) a document in DIF (device independent format) from a resource limited client system, the print rendering service has two modes of operation: (1) the first in which the client is attached to a local printer, in which case the server system transmits a document in PRF (Print-Ready Format) for the corresponding document in document in DIF to the client for printing at the local printer (see column 6, lines 3-8); and (2) the second in which the client is not attached to the local printer but instead either (a) a nearby thin client or (b) the network, in which case the server system transmits the PRF directly to (a) or (b) and not to the client that sent the corresponding document in DIF (see column 6, lines 10-15).

Unlike Carter, Nara discloses a transcoding system (140) for transcoding a

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document before it is transmitted to a mobile station (120) in accordance with its display capabilities (see Abstract and Figure 1). The mobile station as a result of putting the document in a format suitable for viewing at the mobile station is "freed of having locally to substantially modify the document according to the document display capabilities" (see Abstract). More broadly, the transcoding system modifies "documents to accommodate features or limitations of the mobile stations to which they are to be transmitted before they are actually transmitted" (see column 2, lines 62-64).

In contrast, Applicant's invention recited in claim 1 concerns the bridging of communications between an output device and a document server using a mobile computing device on which a document service request is initiated. In executing the document service request, the mobile computing device communicates over a first communication channel with the output device and a second communication channel with the document server.

Further as claimed by Applicant in independent claim 1, the mobile computing device in bridging the communications between the first communication channel and second communication channel: (a) *executes a discovery request* over the first communication channel to identify one or more output devices; and (b) receives from the output device in response to the discovery request a list of available services that specifies a desired or preferred format in which to receive an electronic document.

Unlike Applicant's claimed invention, Carter instead discloses that "the client only *queries the print system on the server* for default job and printer properties based on the device names for the printers at initial setup and stores them locally" (see Carter column 4, lines 50-53, emphasis added), while Nara only concerns transcoding document for display at the mobile device (see Nara column 5, lines 36-52). Thus, Carter taken singly or in combination with Nara fails to suggest or disclose the execution of a discovery request over a first communication channel to identify one or more output devices.

Moreover as claimed by Applicant in independent claim 1, the mobile device specifies a document service request in response to user input that includes a first parameter identifying *a location of the electronic document* and a second parameter

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identifying a type of output device for performing the document service request. Further as claimed by Applicant in independent claim 1, the mobile device transmits the document service request to a document server renders the electronic document, which location is *identified by the first parameter*, into a format suitable for an output device identified by the second parameter.

Unlike Applicant's claimed invention, Carter does not disclose or suggest transmitting the location of an electronic document from its thin client to the print rendering server, but instead discloses the transmission of *device independent data* directly from the thin client to the print rendering server (see Carter column 4, lines 54-59). In contrast, Nara fails to disclose or suggest communicating with an output device over a communication channel. Nara instead concerns the preparation of the display of a document on the mobile device (see Nara column 7, lines 39-63). Applicant respectfully submits that the combination of Carter and Nara is misplaced because in the event it is determined no-transcoding is necessary for viewing a document at the mobile device, the document is transmitted from the transcoding circuit to the mobile device in its "native format" (see Nara column 7, lines 39-63). Subsequently, according to Carter, a thin client prints by sending a document in its "native format" to a print rendering server. Thus, the combination of Carter with Nara fails to disclose or suggest transmitting the location of an electronic document from its thin client to a print rendering server.

In addition as claimed by Applicant in independent claim 1, the mobile device transmits to the output device over the first wireless communication channel the rendered electronic document it receives from the document server over the second wireless communication channel. In contrast, neither Carter or Nara disclose or suggest using two wireless communication channels at a mobile device to control a document service request, as claimed by Applicant in independent claim 1. Instead, Carter discloses that when a printer is not connected to a thin client, the print rendering server routes the print ready document either directly to (i) a printer attached to the network, or (ii) a printer attached to a nearby thin client (see Carter column 6, lines 3-15). Nara instead concerns communication over a single communication channel between a mobile system and a transcoding system. Thus, Carter taken singly or in combination with Nara fails to disclose or suggest the use of a mobile computing device that communicates with an output device, over a first

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wireless communication channel, and a document server, over a second wireless communication channel.

In summary, Carter taken singly or in combination with Nara fails to disclose or suggest, a mobile computing device, as claimed by Applicant in independent claim 1, that in response to a document service request (i) executes, over a first communication channel, a discovery request to identify one or more output devices, and (ii) transmits, over a second communication channel, to a document server a location of a document for rendering into a format suitable for the output device, where (iii) the mobile device transmits to the output device over the first wireless communication channel the rendered electronic document it receives from the document server over the second wireless communication channel.

It should be noted that independent claims 25 and 30 contain the same or very similar limitations to those discussed above with respect to claim 1, and therefore the argument presented above with regard to claim 1 applies equally to independent claims 25 and 30. Accordingly, Applicant respectfully submits that independent claim 1, 25, and 30 are patentably distinguishable over Carter in view of Nara.

Insofar as claims 2-3, 5-8, 10-11, 26-29, and 31-35 are concerned, these claims depend from one of now presumably allowable independent claims 1, 25, and 35 and are also believed to be in allowable condition.

In addition, the Office Action starting on page 6 rejects claims 13 and 14 under 35 USC 103(a) as being unpatentable over Carter in view of Nara in further view of Parulski et al., U.S. Patent No. 5,666,159. Further, the Office Action rejects claims 19 and 22 under 35 USC 103(a) as being unpatentable over Carter in view of Nara in further view of Wolff, U.S. Patent No. 6,738,841. As these claims incorporate the limitations of independent claim 1, there is no need to specifically address the merits of the claims 13, 14, 19, and 22 which are believed to be patentable for the reasons set forth above with regards to claim 1.

For the record, the Office Action states on page 8, lines 1-2 that claims "25-35 do not define any new limitations above the teaching of claims 1-22 and are therefore rejected for the above mentioned reasons". Applicant submits that claim 35 which depends on claim 1 together with claims 28 and 33 set forth limitations that

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are not found in any of claims 1-22. Therefore, Applicant respectfully requests in a subsequent correspondence their reasons for rejection, if the claims 28, 33, and 35 continue to be rejected over the art of record.

2. PTO 1449 Attachment Not Received For Two Supplemental IDS

The Applicant has not received a copy of the PTO-1449 submitted with the Supplemental Information Disclosure Statements mailed **January 31, 2002** (with one additional cited reference) and the Supplemental Information Disclosure Statement faxed **April 20, 2004** (with two additional cited references). Applicants respectfully request receiving in a future correspondence a copy of the PTO-1449 for each of these supplemental information disclosure statements that include notations indicating that the Examiner has reviewed the cited reference. Copies of each supplemental information disclosure statement (together with their confirmation of receipt from the PTO but without their cited references) are attached to this Amendment.

With specific reference to the Supplemental Information Disclosure Statement faxed April 20, 2004, US Patent Applications US 2004/0122932 A1 and US 2004/0139229 A1, which claim priority to WO 02/061569 A2 and WO 03/009523 A2 cited in the Supplemental Information Disclosure Statement faxed April 20, 2004, published on June 24, 2004 and July 15, 2004, respectively. Each of these patent applications is being submitted in a separate supplemental information disclosure statement for further consideration by the Examiner.

3. Fee Authorization And Extension Of Time


No additional fee is believed to be required for this amendment or response, however, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

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4. Conclusion

In view of the foregoing remarks, reconsideration of this application and allowance thereof are earnestly solicited. In the event the Examiner considers a personal contact advantageous to the disposition of this case, the Examiner is hereby requested to call Attorney for Applicant(s), Thomas Zell.

Respectfully submitted,



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Date: August 6, 2004